

REMARKS

Claims 1-33 are currently pending. In the March 10, 2005, Office Action, the Examiner objected to the drawings and specification because of informalities relating to the reference item 964 in Figure 9C and to the presence of hyperlinks in the disclosure. Claim 10 was also rejected under 35 U.S.C. § 112 as being indefinite in reciting a dependency from claim “A1.” In addition, claims 1, 4-5, 8, 11-12, 15-16, 19, 22-23, 26-27, 30 and 33 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,345,292 to Daugherty et al. (hereinafter “Daugherty”); claims 2-3, 13-14, and 24-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daugherty and Official Notice; claims 6-7, 17-18 and 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daugherty and Borenstein et al. “MIME: Mechanisms for Specifying and Describing the Format of Internet Message Bodies” (hereinafter “RFC 1341”); and claims 9-10, 20-21, and 31-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daugherty and U.S. Patent No. 5,987,480 to Donohue (hereinafter “Donohue”). Applicants respectfully traverse the rejections for the reasons set forth hereinbelow.

A. Amendment to Specification

In the Office Action, the Examiner objected to the drawings because Figure 9C contained a reference character (964) not mentioned in the description. In response, Applicants have amended the description to include a reference to numeral 964 in accordance with the originally submitted Figure 9C which refers to the “Return Multi-Part MIME Response” step with reference number 964.

As for the objection to the disclosure for containing an “embedded hyperlink and/or other form of browser-executable code,” Applicants respectfully submit that the cited MPEP provision prohibits incorporation by reference by hyperlink or other form of browser executable code. *See*, MPEP § 608.01(VII)(“Examiners must review patent applications to make certain that hyperlinks and other forms of browser-executable code, especially commercial site URLs, are not included in a patent application. 37 CFR 1.57(d) states that an incorporation by reference by hyperlink or other form of browser executable code is not permitted.”) (emphasis added). The passage from the disclosure referenced by the Examiner (on page 49 of the application) is not incorporating any subject matter by reference, but instead is providing an example web address

to show how a cache ID could be formed. In addition, Applicants submit further that the referenced passage does not include a URL address, as will be immediately apparent from the reference to “foo.bar” in the example (and imaginary) URI link, <http://foo.bar.com/buyme?p1=param1&p3=param3>. Accordingly, Applicants respectfully request that the objections to the drawings and disclosure be withdrawn.

B. Amended Claim 10 Is Definite

As amended, claim 10 depends from claim 1, thereby correcting the typographical error in the originally filed claim. Accordingly, Applicants respectfully request that the indefiniteness rejection of claim 10 be withdrawn and that the claim be allowed.

C. Claims 1, 4-5, 8, 11-12, 15-16, 19, 22-23, 26-27, 30 and 33 Are Not Anticipated by Daugherty

In response to the Examiner’s rejection of claims 1, 4-5, 8, 11-12, 15-16, 19, 22-23, 26-27, 30 and 33 as being anticipated by Daugherty, Applicants respectfully request reconsideration and withdrawal of the rejection because Daugherty’s disclosure -- of an architecture for rendering web pages by requesting un-cached clips one clip at a time -- does not anticipate the present invention’s scheme for aggregating multiple cache requests within a single message. *See, e.g.*, Application, pages 99-104 (paragraphs 319-329). This scheme is variously recited in the claims with reference to searching the cache to identify “a set of fragments associated with a set of source identifiers are not in the cache” and then “sending a first request message comprising the set of source identifiers” previously determined to be missing from the cache. *See, e.g.*, independent claims 1, 12, and 23. The scheme is also recited in the claims with reference to “sending a first request message comprising a plurality of source identifiers associated with the plurality of the set of fragments not in the cache.” *See, e.g.*, independent claims 11, 22, and 33.

Applicants respectfully submit that the claim rejections completely ignore the specific language of the claims that recite aggregating multiple cache requests within a single message. For example, the rejection of each of the independent claims 1, 11, 12, 22, 23 and 33 states that this feature is found in Daugherty at column 5, line 49 through column 6, line 13. *See, Office Action*, pp. 3-4 (March 10, 2005). However, a careful reading of the cited passage confirms that Daugherty is not disclosing the present invention’s use of a sending a first request message

comprising a plurality of missing (or un-cached) source identifiers to obtain a first response message comprising the set of fragments. Indeed, Daugherty make it quite clear that any missing clips from a first cache 110 are retrieved one at a time from another (second) cache source. See, Daugherty, col. 6, lines 39-41 (“If a particular clip requested by the ISAPI 106 is not in the first-level cache 110, the cache 110 requests the clip from the second server 104.”) (emphasis added). The one-at-a-time clip replacement scheme is *repeatedly* described in Daugherty:

[I]f a particular clip requested by the first server 102 is not in the second-level cache 112, either, then the cache 112 requests the clip from the provider interface 114. The provider interface 114 maps the clip requested to the correct provider object. Each provider object at the second server 104 thus populates the second-level cache 112 with any of the clips not yet stored at the second-level cache 112. Therefore, the interface 114 may direct the clip request to a generic object 116, a stock object 118, or a weather object 120, in the embodiment of FIG. 2, although the invention is not necessarily so limited.

Once a provider object returns the HTML clip requested to the provider interface 114, the clip is stored in the second-level cache 112, provided to and also stored in the first-level cache 110, and ultimately provided to the ISAPI 106. Therefore, when the ISAPI 106 requests an HTML clip, three situations may occur. If the cache 110 has the clip stored therein, it immediately returns the clip to the ISAPI 106. If the cache 110 does not have the clip, but the cache 112 does, then the cache 112 returns the clip to the cache 110, which stores the clip and returns it to the ISAPI 106. If neither cache has the clip, then the provider interface 114 obtains the clip from one of the provider objects, returns it to the cache 112 where the clip is stored, and the cache 112 provides it to the cache 110, which also stores the clip and returns it to the ISAPI 106.

See also, Daugherty, col. 7, lines 9-34 (emphasis added).

At best, Daugherty discloses an HTML clip caching technique whereby any clips missing from a first-level cache are retrieved one at a time from a second-level cache. With the present invention, multiple cache requests are aggregated in a single message by including a plurality of source identifiers for uncached fragments to more efficiently assemble a set of fragments. Because Daugherty does not disclose sending a request message in which are aggregated the source identifiers for the uncached fragments, Daugherty cannot be used as an anticipatory reference against the claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). Accordingly, Applicants respectfully request that the anticipation rejection of claims 1, 4-5, 8, 11-12, 15-16, 19, 22-23, 26-27, 30 and 33 be withdrawn and that the claims be allowed.

D. Claims 2-3, 6-7, 9-10, 13-14, 17-18, 20-21, 24-25 and 28-29 and 31-32 Are Not Obvious

In response to the Examiner's rejection of claims 2-3, 6-7, 9-10, 13-14, 17-18, 20-21, 24-25 and 28-29 and 31-32 over Daugherty and the various combinations with "Official Notice," RFC 1341 and Donohue, Applicants respectfully request reconsideration and withdrawal of the rejection because the Examiner has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Where a rejection is based on the assertion that all claim limitations are found in a number of prior art references, the fact finder must determine "[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references." In re Fulton, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004). The motivation-to-combine inquiry "prevent[s] statutorily proscribed hindsight reasoning when determining the obviousness of an invention." Alza Corp. v. Mylan Labs., Inc., No. 06-1019 (Fed. Cir. Sept. 6, 2006). Thus, in the absence of any *explicit* suggestion in the cited references that they should be combined, the Examiner must show that an *implicit* suggestion to combine these references may be found in the "common knowledge, the prior art as a whole, or the nature of the problem itself." Dystar Textilfarben GMBH v. C.H. Patrick Co., No. 06-1088, pp. 7-8 (Fed. Cir. 2006). When a motivation to combine is not explicitly taught by the prior art references, the "evidence" of motive may be provided as an explanation of the well-known principle or problem-solving strategy to be applied, but in any event *requires* some evidence of any common knowledge and common sense, above and beyond mere assumption. Id., pp. 17-20.

As a preliminary matter, a *prima facie* case of obviousness has not been established because, as noted above, none of the references, alone or in combination, discloses or suggests sending a request message that includes "a plurality of source identifiers" associated with the fragments not in the cache (as variously recited in claims 1-33). These deficiencies are not remedied by the Examiner's citation to Official Notice (that recursion has been well known in the field of computer science), the RFC 1341 (MIME message formats) or Donohue. To the extent that the additional requirements of dependent claims 2-3, 6-7, 9-10, 13-14, 17-18, 20-21, 24-25 and 28-29 and 31-32 are admitted to be missing from the Daugherty disclosure, and are

only remedied by the selective combination of the “Official Notice,” RFC 1341 and Donohue, Applicants submit that the Examiner has engaged in improper hindsight reconstruction by using the Applicants invention to selectively pick and choose from the cited art.

As for the specific requirements recited in dependent claims 2-3, 13-14, and 24-25 that the Examiner concedes are missing from Daugherty, the Examiner invokes “Official Notice” to meet the missing requirements. Applicants respectfully submit that the Examiner has improperly relied upon Official Notice in asserting that the requirements of these claims are satisfied by the assertion that “recursion has been well known in the field of computer science for decades.” See, Office Action, p. 5. For example, Applicants submit that the requirements of claim 2 -- which requires determining if a fragment has a set of linking elements for a set of next-level fragments, and scanning the fragment to retrieve source identifiers from the linking element -- are not satisfied by the assertion that “recursion has been well known.” Nor are the requirements of claim 3 -- retrieving and combining fragments -- met by the “recursion” assertion. Accordingly, Applicants hereby challenge the factual assertion in the Official Notice, and request that the Examiner provide documentary evidence in support of the assertion showing how the specific requirements of claims 2-3, 13-14, and 24-25 are disclosed in the prior art. See, MPEP § 2144.03(C) (Rev. 5, August 2006) (“If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2).”).

Likewise, the Examiner concedes that the additional requirements recited in dependent claims 6-7, 17-18 and 28-29 are missing from Daugherty, but asserts that the disclosure of MIME message formats disclosed in RFC 1341 meets the missing requirements. See, Office Action, p. 5. However, there is nothing in RFC 1341 to suggest that response messages containing multiple uncached fragments are sent as “a multi-part MIME” message, as variously recited in claims 6-7, 17-18 and 28-29. As for claims 9-10, 20-21, and 31-32, the Examiner admits that the additional requirements of these claims (reciting the use of SGML linking elements and HTTP request and response messages) are not met by Daugherty, but seeks to overcome this deficiency by invoking the disclosure of Donohue. However, the proposed combination appears to conflict with Daugherty’s disclosure of using XML data structures and cache transfer messages, in effect teaching away from the Donohue disclosure. When, as here, the Daugherty reference teaches away from the claimed invention, a *prima facie* case of

obviousness has been rebutted. *See*, MPEP § 2144.05(III) (“A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). . .”).

In the absence of any proper evidence that persons skilled in the art would be motivated to combine the references, this appears to be a textbook example of hindsight reconstruction. Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). In short, the Examiner has not made a *prima facie* case that the combination of Daugherty, “Official Notice,” RFC 1341 and Donohue were suggested by the prior art, common knowledge, or the nature of the problem, viewed through the eyes of an ordinary artisan, but has instead improperly relied upon Applicants’ disclosure to reconstruct the prior art. Accordingly, Applicants respectfully request that the obviousness rejection of claims 2-3, 6-7, 9-10, 13-14, 17-18, 20-21, 24-25 and 28-29 and 31-32 be withdrawn and that the claims be allowed.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

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Respectfully submitted,

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